

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of:

**H. FLECK et al.** : Confirmation No.: **8579**  
Application Serial No.: **10/785,423** : Group/Art Unit: **2618**  
Filing Date: **February 23, 2004** : Examiner: **Qouchien VUONG**  
Title: *Automated Data Migration*

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST TO WITHDRAW FINAL OFFICE ACTION**

Sir:

In response to the final Office Action of December 9, 2009 and in furtherance of the Request to Withdrawal Final Office Action filed December 16, 2009, applicant respectfully requests withdrawal of the finality of the Office Action for the reasons below:

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REMARKS

This additional Request for Withdrawal of Final Office Action is in furtherance of the previous Request filed December 16, 2009 in response to the final Office Action of December 9, 2009. Applicant submits this additional Request in response to applicant's telephone conference with Examiner Young of March 18, 2010. Applicant would like to thank Examiner Young for his helpful comments during the telephone conference in explaining the Examiner's reasoning for issuing a final Office Action after a Notice of Panel Decision reopening prosecution.

The Examiner asserts that the Office Action of December 9, 2009 was made final, even though it included a new ground of rejection (Ito et al. EP 1 359 777) and was issued after a Notice of Panel Decision (September 2, 2009) reopening prosecution, because applicant's amendments in response to the non-final Office Action of February 8, 2008 necessitated the new ground of rejection. Applicant respectfully notes that nowhere in the final Office Action of December 9, 2009 does the Examiner state that the new grounds of rejection were necessitated by applicant's amendment. Furthermore, even after applicant amended the claims in response to the non-final Office Action of February 8, 2008, the Examiner<sup>1</sup> issued a final Office Action on August 18, 2008 maintaining the rejections of the non-final Office Action.

In response to the final Office Action of August 18, 2008 applicant filed a Pre-Appeal Brief Request for Review along with a Notice of Appeal. In response to the Pre-Appeal Brief Request for Review the Office withdrew the rejections of the final Office Action of August 18, 2008 and reopened prosecution. Accordingly, the Notice of Panel Decision of September 2, 2009 determined that the rejections of the August 18, 2008 final Office Action were improper. Applicant respectfully submits that the Office cannot issue a final Office Action applying a new ground of rejection as the first Office Action after a Notice of Panel Decision in which prosecution was reopened. Therefore, for at least the following reasons applicant respectfully requests withdrawal of the finality of the Office Action, and that the period for reply be restarted as of the mailing date of the new non-final Office Action.

First, the Notice of Panel Decision of September 2, 2009 determined to reopen prosecution in response to the Pre-Appeal Brief Request for Review filed November 21, 2008. The OG Notice for the New Pre-Appeal Brief Conference Pilot Program states that "the decision will state...[p]rosecution on the merits is reopened and an appropriate Office communication will follow in due course." See OFFICIAL GAZETTE NOTICES FOR 2005, Week #28 "New Pre-Appeal Brief Conference Pilot Program" (July 12, 2005); see also Extension of the Pilot Pre-Appeal Brief

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<sup>1</sup> The Examiner maintains that the final Office Action of August 18, 2008 was issued by the previous Examiner for this application, and acknowledges that it was improper.

Conference Program (January 10, 2006). It is well understood that a final Office Action closes prosecution on the merits. *See* MPEP § 706.07 Form paragraph 7.39.01 (this action is a final rejection and is intended to close the prosecution of this application); *see also* MPEP § 609.04(b) (prior to the date the prosecution of the application closes, i.e. before the mailing date of a final action under 37 C.F.R. § 1.113). Therefore, the Examiner has acted in direct contradiction to the Notice of Panel Decision reopening prosecution by issuing a final Office Action closing prosecution. The Pre-Appeal Brief Conference Program does not allow the Examiner to issue a final Office Action, because the prosecution of the application is not reopened as a result of the final Office Action. Accordingly, for at least this reason the finality of the Office Action of December 9, 2009 is improper, and applicant respectfully requests that the Office Action be withdrawn.

Second, a second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p).<sup>2</sup> *See* MPEP § 706.07(a). The Examiner asserted during the telephone conference of March 18, 2010 that the final rejection was necessitated by applicant's amendment. As noted above, applicant respectfully notes that this is the first time the Examiner informed applicant of this reason, since this reasoning is not stated anywhere in the Office Action. When applicant informed the Examiner that no amendment was submitted with the Pre-Appeal Brief Request for Review, the Examiner asserts that the amendment filed in response to the non-final Office Action of February 8, 2008 necessitated the new grounds of rejection in this final Office Action. However, even if it is proper to issue a final Office Action anytime after an applicant has amended claims even if a previous Office Action was made final and withdrawn,<sup>3</sup> which applicant does not admit, the new grounds of rejection in this final Office Action were not necessitated by applicant's amendment. Instead, the new grounds of rejection were necessitated by the Notice of Panel Decision determining that the previous grounds of rejection were incorrect. As a result of the Notice of Panel Decision, the Examiner was forced to find new grounds of rejection, and therefore the withdrawal of the previous final rejection necessitated the new grounds of rejection, not an amendment made to the

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<sup>2</sup> The new ground of rejection in the Office Action is based on Ito et al. (EP 1 359 777). Ito was cited in an IDS filed June 6, 2005 during the time period specified in 37 C.F.R. § 1.97(b)(3), and therefore the final Office Action is not based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c).

<sup>3</sup> This would be completely contrary to the Office's policy regarding final rejections that before a final rejection is in order a clear issue should be developed between the examiner and applicant. *See* MPEP § 706.07. In issuing a new final Office Action with new grounds of rejection, the Examiner would not be providing the applicant with an opportunity to develop a clear issue that would support issuance of the new final Office Action.

claims in response to a non-final Office Action. Accordingly, for at least this reason the finality of the Office Action of December 9, 2009 is improper, and applicant respectfully requests that the Office Action be withdrawn.

Third, the intent of the Pre-Appeal Brief Conference Program is “to spare applicants the added time and expenses of preparing an appeal brief if a panel review determines an application is not in condition for appeal...in the proper situations it can save both the resources of the applicant and the Office.” *See* OFFICIAL GAZETTE NOTICES FOR 2005, Week #28 “New Pre-Appeal Brief Conference Pilot Program” (July 12, 2005). After an appeal brief or reply brief the examiner may reopen prosecution in order to make a new ground of rejection of claims, and the Office Action following a reopening of prosecution may be made final if all new grounds of rejection were necessitated by amendment. *See* MPEP § 1207.04. Therefore, a final Office Action may only be issued after the filing of an appeal brief or reply brief in the limited circumstances in which the new grounds of rejection are necessitated by amendment. However, as stated above, this would only be the case if the applicant had amended the claims in response to the previous final Office Action, for example if the applicant had submitted an amendment after final which was not entered before filing the appeal brief. *See* MPEP § 1207.04. It would be contrary to the purpose of the Pre-Appeal Brief Conference Program if applicants were placed in worse situation than if they had proceeded with filing an appeal brief. For example, as in this case where the applicant has received a final Office Action with new ground of rejection after a favorable Notice of Panel Decision. Accordingly, for at least this reason the finality of the Office Action of December 9, 2009 is improper, and applicant respectfully requests that the Office Action be withdrawn.

Finally, since the Office Action of December 9, 2009 should not have been made final, the Office Action contains an error that affects applicant’s ability to reply to the Office Action. This error was called to the attention of the Office on December 16, 2009, i.e. within 1 month from the mail date of the Office Action, and therefore applicant respectfully submits that the previously set period of reply should be restarted from the date that the error is corrected. *See* MPEP § 710.06; *see also* MPEP § 706.07(c) (any question as to prematurity of a final rejection should be raised while the application is still pending before the primary examiner).

Conclusion

Therefore, applicant respectfully requests withdrawal of the finality of the Office Action, and that the period for reply be restarted as of the mailing date of the new non-final Office Action. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

Dated: 19 March 2010

/s/Keith R. Obert/

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